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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,054	03/28/2001	Adam R. Schran	10397-1U1	3079

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AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/820,054	Applicant(s) SCHRAN ET AL.	
	Examiner Etienne P LeRoux	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Request for Reconsideration

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claims Status

Claims 1-30 are pending. Claims 1-30 are rejected as detailed below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Norton Internet Security 2000 [hereafter NIS 2000]¹.

Claims 1 and 16:

NIS 2000 provides:

- (a) receiving at a server a request from a subscriber to send a list of cookie file sources [Jay - Black website list]²
- b) downloading the list [free updates - Jay]

¹ Symantec Bundles Safe Surfing Tools – Alexandra Krasne, discloses Norton Internet Security 2000 scheduled to ship at the end of November, 1999.

² Norton Internet Security 2000 – Review by Julien Jay

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c) using the downloaded list to detect files received at the client machine from sources on the downloaded list [NIS can block cookies – Jay]

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Pub No US

2002/0055912 issued to Buck (hereafter Buck).

Claims 1 and 16:

Buck discloses:

- a) receiving at a server [e-Privacy site 24, Fig 1B, e-Privacy software 26, Fig 1B, paragraph 43] a request from a subscriber [PC 12, Fig 1B, paragraph 43, computer user guaranteed privacy, paragraph 39] to send a list [member of e-Privacy network, paragraph 45, e-Privacy list of vendor members, paragraph 58] of cookie file sources [vendor sends cookie, paragraph 45] to the client machine [user PC 12, Fig 1B, paragraph 43]
- b) downloading the list from the server to the client machine [process of verification and authentication occurs during each session, paragraph 45]
- c) using the downloaded list to detect files received at the client machine from sources on the downloaded list [disposition of the cookie, paragraph 45]

Claim 2 and 17:

Buck discloses (d) creating a first exception list including the identity of sources that are permitted to store cookies in the client machine [members of e-Privacy network, paragraph 22] (e) creating a second exception list including the identity sources that are not permitted to store cookie files in the client machine [inherent in the following: paragraph 51 discloses because cookies are tracked and paragraphs 45 and 48 discloses a member list], (f) modifying the downloaded list in accordance with the first and second exception lists [list of members is updated, paragraph 58].

Claims 3, 9, 18 and 24:

Buck discloses receiving updates of the downloaded list from the server on a periodic basis [paragraph 58]

Claim 4 and 19:

Buck discloses displaying a message at the client machine indicating that a cookie file received from a source on the downloaded list has been detected [paragraph 44]

Claims 5, 10, 14, 20, 25 and 29:

Buck discloses (d) removing the detected cookie file stored in the client machine [paragraph 46]

Claims 6, 11, 15, 21, 26 and 30:

Buck discloses preventing detecting cookie files from being stored in a client [paragraph 46].

Claims 7 and 22:

Buck discloses (a) creating a first exception list including the identity of sources that are permitted to store cookie files in the client machine [member of e-Privacy network, paragraph

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45, e-Privacy list of vendor members, paragraph 58] , (b) creating a second exception list including the identity of sources that are not permitted to store cookie files in the client machine [inherent in the following: paragraph 51 discloses because cookies are tracked and paragraphs 45 and 48 discloses a member list], (c) receiving at the client machine, from a service provider, a master list of cookie file sources [paragraph 51 discloses because cookies are tracked], (d) modifying the master list in accordance with the first and second exception lists, wherein the complete list is the modified master list [list of members is updated, paragraph 58].

Claims 8 and 23 and 28:

Buck discloses wherein the composite list is stored in the client machine independent of the first exception list, the second exception list and the received master list [paragraph 43]

Claims 12 and 27:

Buck discloses

(a) receiving at the client machine, from the service provider, a master list of file sources [all cookies, paragraph 51], (b) deleting cookie file sources from the master list that correspond to one or more trusted file cookie file sources listed in the client machine [list of vendor members, paragraph 58], (c) adding cookie file sources to the master list that correspond to one or more untrusted file sources listed in the client machine, wherein the composite list is the master list as modified by any additions and deletions of trusted and untrusted cookie file sources [inherent in the all cookies list minus the vendor member list].

Claim 13:

Buck discloses the master list and the composite list are stored independently in the client machine [paragraph 43]

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Claims 1 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,678,731 issued to Howard et al (hereafter Howard).

Claims 1 and 16:

Howard discloses:

- a) receiving at a server [authentication server, col 7, lines 25-40] a request from a subscriber [user, col 7, lines 25-40] to send a list [list of all web sites or servers, col 7, lines 25-40] of cookie file sources [col 7, lines 25-40]
- b) downloading the list from the server to the client machine [col 7, lines 25-40]
- c) using the downloaded list to detect files received at the client machine from sources on the downloaded list [col 7, lines 25-40]

Response to Arguments

Applicant's arguments filed 9/18/2005 have been considered and found partially persuasive but are now moot in view of above new grounds of rejection. Applicant's arguments are only partially persuasive for the reasons given below.

Applicant Argues:

Applicant argues that Montulli does not disclose "receiving, at a server, a request from a subscriber to send a list of cookie file sources to the client machine."

Examiner Responds:

Examiner is only partially persuaded. Montulli discloses that the client receives a list of cookie file sources at the client machine. However, the list of cookie file sources is obtained as a result of the client requesting at the server product information which is transmitted to the client in the form of a set of cookies (list of cookies) which include product source information (web-site information). Montulli therefore, does not disclose that the list of cookie file sources is obtained as a result of the client requesting a list of cookie file sources per the claim language.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: (1) US Pat No 6,851,060 issued to Shrader discloses deleting cookies identified in a list and (2) Pub No US 2001/0049620 discloses a software tool that can block cookies and erase pre-existing cookies.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on 8:00-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

11/15/2005



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